

REMARKS

This paper is responsive to an Office Action dated March 8, 2004. Prior to this response, claims 1-6, 8-15, and 17 were pending. After amending claims 1-2, 4, 9-10, 12, and 17, and canceling claim 3, claims 1-2, 4-6, 8-15, and 17 remain pending.

Sections 4 through 9 of the Office Action state that the objections made to the specification, and the rejections made to the claims under 35 U.S.C. 112 made in the previous Office Action have been removed.

In Section 13 of the Office Action claims 1 and 10 have been rejected under 35 U.S.C. 102(b) as being anticipated by Tokuda et al. ("Tokuda"; US 6,038,541). The Office Action states that Tokuda discloses a process for supplying folder with scripts; selecting a folder; processing a document; and adding the processed document to the selected folder. This rejection is traversed as follows.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As noted in the Applicant's previous response, Tokuda describes a process that accepts a number of document types, sorts the documents according type, and sends them along a workflow path in response to the classification steps. Tokuda differentiates between documents on the basis of document content. Once the document type is determined, the document can only be sent along a single workflow path

(the path matching the document type). Tokuda explains how a particular document type (120-126) is sent to a corresponding unit (business groups) 112 through 118, at col. 5, ln. 25-28.

The invention of claims 1 and 10 permits a document to be processed in accordance with a plurality of scripts. In the claimed invention, the document is not limited to a single workflow path. In the *Response to Arguments* Section of the Final Office Action (page 4), the Examiner argues that Tokuda describes the method step of *selecting a first number of folders*, because “the function unit 104 selects the unit workflow according to the type of document.” The Applicant does not believe that the term “selection” describes a process that has only one possible result given a particular input. Such a process would more properly be termed a channeling process. However to advance the claims to issue, the claims have been amended to recite that the accepted documents are capable of being processed by any of a plurality of scripts. Claims 1 and 10 can now clearly be distinguished from Tokuda, regardless of how the term “selecting” is interpreted, because Tokuda’s process accepts a document that can only be advanced along a single workflow path.

Since Tokuda does not explicitly describe every step of the inventions of claims 1 and 10, he cannot anticipate. The Applicant respectfully requests that the rejection be removed.

In Section 15 of the Office Action claims 2-6, 8-15, and 17 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Tokuda, in view of Matsuo et al. (“Matsuo”; US 6,775,729) and further in view of SAMS, Teach Yourself Javascript in 24 Hours (“SAMS”). With respect to claims 2, 9, 11, and 17, the Office Action acknowledges that

Tokuda does not disclose an MFP or the recited processing operations, but states that Matsuo describes an MFP, and that it would have been obvious "to use Matsuo's MFP in Tokuda because this would provide Tokuda with control functions for scanner, fax, printer and photocopier." This rejection is traversed as follows.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, there are three requirements to establish a *prima facie* case of obviousness.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck* 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991).

In the *Response to Arguments* Section of the Final Office Action (page 6), the Examiner states that the motivation to combine references exists because "one of ordinary skill in the art would have been motivated to replace additional rules or scripts in each unit workflow to execute a MFP device in order to provide automated functions such as scanning, faxing, printing and photocopying the associated document."

However, the above-quoted statement does not support the first *prima facie* requirement. Tokuda describes a process where a document is sent along a workflow path on the basis of document type. To prove "motivation", the Office Action must supply a reason why an artisan

would modify Tokuda in such a way as to describe the claimed invention. Matsuo, at col. 1, ln. 35-67, describes device control programs, for maintaining the functions of the MFP scanner and print engines, which are executed in the event of a job interruption. Since Matsuo does not describe any kind of process for moving a document along parallel workflow paths, it is difficult to image how Matsuo could suggest such a modification to Tokuda. Alternately stated, it appears as if the two references were combined in retrospect as the result of a keyword search. To satisfy the first *prima facie* requirement, the Office Action must explain why Matsuo's MFP scan and print engines suggest a reason that Tokuda's invention be changed from a process that channels a workflow on the basis of document type, to a process where the user is able to select the script that is to be applied to a document. It is clear that the Matsuo reference cannot supply this kind of motivation.

Neither has the Office Action demonstrated that the modification of the cited the prior art references points to the reasonable expectation of success in the present invention. In the *Response to Arguments* Section of the Final Office Action it states "the expectation of success of such modification to Tokuda is reasonable in view of the common application of process automation using workflow, scripts and control devices in the industry." However, this statement fails to address the second *prima facie* requirement. Rather, the Office Action must supply a rationalization for how an artisan, using the Tokuda, Matsuo, and SAMS references as a foundation, could reasonable to expected to derive the claimed invention without undue experimentation. Since none of the references describe a process where the user can select a workflow path for a document, or describe a process where a document can be

parallel processed along multiple workflow paths, the Applicant believes that no reasonable expectation is possible.

With respect to the third *prima facie* obviousness requirement, the references even when combined do not disclose all the elements of the claimed invention. With respect to claims 1 and 10, neither Matsuo nor Tokuda describe a process that accepts a document capable of being processed using a plurality of different scripts, and selects the folder (script) to be used for processing the document. As noted above in response to the anticipation rejection, regardless of how the term "selecting" is defined, Tokuda does not describe a process that selects a workflow path for a document that is capable of being processed using a plurality of different scripts. Matsuo and SAMS don't even address to the issue of workflow or document scripts.

Claim 9 has been amended to recite that the scripts are pre-selected prior to accepting the document to be processed. As acknowledged by the Examiner on page 4 of the Final Office Action, Tokuda's function sort 104 selects the unit workflow according to the type of document. Therefore, Tokuda's process cannot "select" prior to accepting and examining the document type. None of the references, including Tokuda, describe the "pre-select" limitation of claim 9.

Claim 17 has been amended to recite that a document is processed using a plurality of scripts. As mentioned above, Tokuda's process can only channel a single workflow path for any particular document on the basis of document type. Therefore, Tokuda's process cannot select a plurality of scripts, process a document using a plurality of scripts, or create a plurality of scripted documents from a single inputted

document. None of the references, including Tokuda, describe all the limitations of claim 17.

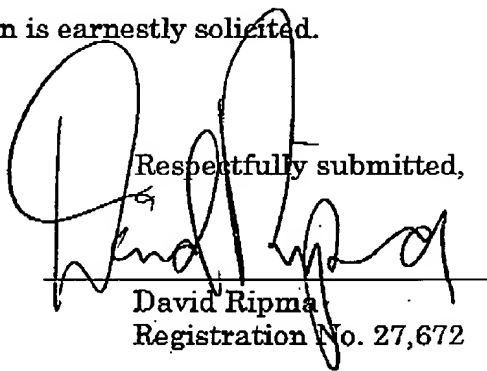
In summary, the combination of references does not disclose all the elements of claims 1, 9, 10, and 17. Neither does the combination of references suggest a modification that makes claims 1, 9, 10, and 17 obvious. Claims 2, 4-6, and 8, dependent from claim 1, and claims 11-15, dependent from claim 10, enjoy the same distinctions from the cited prior art as the base claims, and the Applicant requests that the rejections be removed.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Date:

4/14/05

Respectfully submitted,

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